



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,746	10/15/2001	David Llewellyn Mallis	09432.183002	3552

22511 7590 12/22/2004

OSHA & MAY L.L.P.
1221 MCKINNEY STREET
HOUSTON, TX 77010

EXAMINER


NICHOLSON, ERIC K

ART UNIT	PAPER NUMBER
----------	--------------

3679

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/977,746	Applicant(s) MALLIS ET AL.	
	Examiner Eric K Nicholson	Art Unit 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 10-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Drawing Objections

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “selected clearance ” between “the external stab flank and the internal stab flank” noted in claim 1 must be shown or the features canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement

sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections – 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. In claim 10, lines 9-10 state that "irreversible plastic deformation of the positive stop torque shoulder does not occur upon final makeup". This appears to be inconsistent the

specification as originally filed which on page 6, lines 1-2 states that torque “may be applied to the positive stop torque shoulder prior to final make up, without causing irreversible plastic deformation”. Thus the claims purport that no irreversible plastic deformation occurs at final makeup yet the specification only supports no irreversible plastic deformation prior to final make up. See also page 7, paragraph [0031]. Further, in lines 11-12 of claim 10 it is now stated that a “clearance exists between the external stab flank and the internal stab flank”. It is unclear where this clearance is between the stab flanks and further appears to be conflicting with the disclosure as the specification on page 5, paragraph [0026] and page 7, paragraph [0031] wherein it is stated that a clearance exists at least between the internal and external load and stab flanks.

Claim Rejections – 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10,11,15,16,17,18 and 19 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. patent 5,462,315 to Klementich. The Klementich patent illustrates, for example in figs. 4A-4C and column 21, lines 5-22, a method of coupling threads pipes which includes rotationally engaging a pin member 402 and a box member 406, the pin member 402 having an external thread 416 increasing in width in one direction, the external thread 416 comprising load and stab flanks, the box member 406 having an internal thread 428 increasing in width in the other direction, the internal thread 428 comprising load and stab flanks, the pin member and box member defining a positive stop torque shoulder 408,419 wherein the widths of the external thread and the internal thread are selected such that upon final makeup (column 21, lines 5-6 and line 18) of the connection a selected clearance (column 21, lines 20-21) exists between the external thread and internal thread. As to claim 11, see the positive stop torque shoulder 408 is disposed at an interface of a box face disposed on the box member and a pin outer diameter shoulder 419 disposed on the pin member. As to claim 15, the two-step

configuration (fig. 4C) of the internal thread of the box member and the two-step configuration (fig. 4B) of the external thread of the pin member and the positive stop torque shoulder 408,419 disposed at an interface between the two steps of the pin and box members. As to claim 16 see column 22, lines 50-51 wherein the internal and external threads are adapted to form a metal-to-metal seal. As to claims 17 and 18 see figures 6A,6B and 8B which illustrate a tapered, internal, generally dovetail-shaped thread having stab flanks, load flanks, roots, and crests of the box and pin members.

Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to

which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 5,462,315 to Klementich in view of U.S. patent 4,822,081 to Blose. Klementich discloses the claimed device of a threaded pipe connection as noted above including a pin member 114 having an external thread increasing in width in one direction, the external thread comprising load and stab flanks and a box member 116 having an internal thread increasing in width in the other direction so that complementary internal and external threads move into engagement upon make-up of the connection, the internal thread comprising load and stab flanks and wherein the width of the internal thread and external thread are selected to provide a selected clearance (column 21, lines 15-20) at least between the stab upon final makeup of the connection. Further the thread of Klementich is shown to be a two-step configuration (see figs. 2A-2C for example). However Klementich does not disclose using a positive stop shoulder at either end of the box and pin members. Blose discloses that it is known in the art to provide a similar type coupling with a positive torque shoulder at 41/42, 43, 44 or between the threads as disclosed in column 5, lines 25-30. It would have been obvious to one

having ordinary skill in the art at the time the invention was made to provide the threaded box and pin members of Klementich with positive torque stop shoulders at either end as taught by Blose in order to provide a more secure coupling for the threaded members due to the shoulders assisting the stab flanks of the threaded members in resisting applied axial compressive loads.

Conclusion

Applicant's arguments filed 9-7-04 that claim 10 as amended defines over the prior art of Klementich have been fully considered but they are not persuasive. First, as noted above in the rejection of the claims the now amended claim 10 is not supported to claim that of the positive stop torque shoulder does not occur upon final makeup according to the specification such irreversible plastic deformation is only prohibited prior to final make up. Second, applicant argues that Klementich discloses making up the connection until irreversible plastic deformation occurs in contrast to the present invention giving support for these arguments in col 16-17 and column 22, lines 45-51. The examiner has reviewed the entire specification and finds no support for such arguments either in column 16-17 and col. 22, lines 45-51 or anywhere else. As noted by the examiner the clearance in Klementich

occurs at the stab flanks at a final power tight position as is supported in column 21, lines 5-20. Applicant argues against inherency on page 5 of the remarks yet the examiner has not mentioned inherency in the rejection, to this the examiner can only assume that since claims 10-18 are method claims applicant is arguing that the method of the present invention is not obtainable from the prior art of Klementich. The examiners position is that since the structure of the Klementich is equivalent to that of the present invention such would naturally operate in the same manner to the extent that applicant has really claimed any method steps, for while the claims purport to be method claims the claims are in fact lacking any true steps to which applicant can identify which define the claims as method claims as opposed to product claims. The claims all recite structure with the exception of the step of “rotationally engaging a pin member and a box member”, to which the Klementich coupling does also, with the same claimed structure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

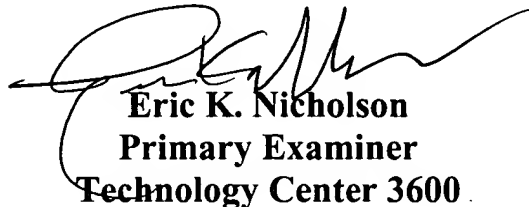
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Nicholson whose telephone number is (703) 308-0829. The examiner can normally be reached on Tuesdays thru Fridays from 7:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola, can be reached on (703) 308-2686. The fax phone number for Technology Center 3600 is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center receptionist whose telephone number is (703) 308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

ekn
12/14/04



Eric K. Nicholson
Primary Examiner
Technology Center 3600